

## REMARKS

In the Office Action dated September 17, 2009, the following rejection is presented: claims 1-31 stand rejected under 35 U.S.C. § 103(a) over the McKissick reference (U.S. Patent Pub. 2007/0124795) in view of the Danker reference (U.S. Patent Pub. No. 2003/0208777) and further in view of Oshita (U.S. Patent No. 5,796,441). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejections of claims 1-31 (each of which is based on the ‘795 reference) because the modification of the ‘795 reference proposed by the Examiner would change the principle of operation of the ‘795 reference. *See, e.g.*, M.P.E.P. § 2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).”).

Applicant has previously explained in detail the impropriety of the Examiner’s proposed modification of the ‘795 reference, to which the Examiner has offered no substantive rebuttal as required, for example by M.P.E.P. § 707.07(f). Instead, the Examiner simply quotes case law relating to “attacking references individually” (of which Applicant is well aware) while continuing to rely upon the same portions of the cited references. The Examiner further mischaracterizes Applicant’s previous arguments by stating that “applicant argues that (the) combination of Mckissick in view of Danker” fails “to disclose ‘broadcasting text messages to a plurality of destination set top boxes’.” Applicant’s previous arguments were directed entirely to the impropriety of the Examiner’s proposed modification of the ‘795 reference, and in particular to the impropriety of modifying the ‘795 reference to broadcast text messages, as proposed by the Examiner. Applicant notes that any discussion of the impropriety of the Examiner’s proposed combination necessarily requires discussing the teachings of the cited references. Applicant submits that the record is clear with regard to the impropriety of the Examiner’s proposed modification of the ‘795 reference due to the Examiner’s failure to provide a substantive rebuttal of Applicant’s previous arguments. The following

discussion particularly addresses the impropriety of the Examiner's proposed modification of the '795 reference.

The '795 reference does not teach broadcasting messages (received from users of set top boxes) to the set top boxes of the desired recipients of these messages. Instead, the cited portions of the '795 reference teach that messages can be exchanged between the users of television equipment devices 100 and 120; the messages are stored on message servers 106, 108 or 110 and the recipients user's set top box downloads the message from the message server after logging on to the message server. *See, e.g.*, Figure 3 and Paragraphs 0077 and 0079. In other words, the '795 reference does not broadcast text messages to a plurality of destination set top boxes as in the claimed invention, but instead teaches that the set top boxes access messages stored on a server on an individual basis. The '795 reference further teaches providing "TV message information" with the television program data, not the actual messages that are exchanged by the users. The TV message information is taught by the '795 reference as being information "that indicates that the television program has associated message options such as those shown in FIG. 4." *See* paragraph 0082. Thus, the '795 reference does not teach broadcasting the actual text messages with the television programming.

Now turning to the impropriety of the Examiner's proposed modification of the '795 reference, the Examiner proposes to modify the '795 reference such that the messages exchanged between users of set top boxes would be multiplexed with audio and video signals and broadcast over a network. *See, e.g.*, pages 5-6 of the instant Office Action. However, Applicant submits that such a modification would change the principle of operation of the '795 reference in that the messages would no longer be stored on a server to be accessed by the intended recipients on an individual basis. In other words, the Examiner is improperly modifying the '795 reference by replacing that which the invention is directed to (*i.e.*, the manner in which messages are exchanged between users of set top boxes). *See also, KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious."). Accordingly, there is no motivation for the skilled artisan to modify the '795 reference in the manner proposed by the Examiner.

In view of the above, the § 103(a) rejections of claims 1-31 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-31 because the Examiner fails to provide a valid reason for the proposed combination of the ‘795 and ‘777 references, thus also failing to cite evidence of motivation for modifying the ‘795 reference. Consistent with M.P.E.P. § 2143.01 and relevant case law, a § 103 rejection must provide evidence of motivation where a proposed combination of references would modify a primary reference. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). In this instance, the Examiner asserts that the skilled artisan would modify the ‘795 reference to broadcast text messages along with television programming “for the purpose of allowing the transportation of the messages through the cable distribution infrastructure together with regular television programming, which avoids the need to include extra transmission mediums.” *See* page 6 of the instant Office Action. However, this hypothetical combination lacks any supporting evidence, and further does not provide a clearly-articulated reason that would be consistent with the *KSR* decision. In particular, the ‘795 reference already allows for messages to be sent using the same communication paths that carry television broadcast signals thereby eliminating the need for additional communication paths (*see, e.g.*, paragraph 0013) as acknowledged and relied upon by the Examiner (*see, e.g.*, pages 2-3 of the instant Office Action).

Unlike the *KSR* decision, where the combination involved combining “two known devices according to their established functions”, the Examiner’s proposed combination does not involve simply combining teachings in which the cited references are not modified in their operation. More specifically, the proposed combination involves extensively modifying the ‘795 reference by replacing the manner in which the ‘795 reference exchanges messages between users of set top boxes, as discussed above. Accordingly, the Examiner’s assertion of such a vague “articulated reasoning” (*e.g.*, to avoid “the need to include extra transmission mediums” which is already done by the ‘795 reference) in support of the modification is insufficient. *KSR* and M.P.E.P. § 2141 make it clear that such assertions are inapplicable where the operation of one of the

references is modified. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). For example, according to M.P.E.P. § 2141, Applicant can rebut such assertions of obviousness simply by showing that “the elements in combination do not merely perform the function that each element performs separately.” This is also consistent with various parts of *KSR*, which repeatedly refer to combined teachings in which the cited references are not modified in their operation. Accordingly, the § 103(a) rejections of claims 1-31 are improper and Applicant requests that they be withdrawn.

Applicant further traverses the § 103(a) rejections of claims 1-31 because the Examiner fails to cite to any reference that teaches broadcasting text messages that are received from users of source set top boxes, as in the claimed invention. As discussed above, the ‘795 reference does not teach broadcasting any text messages. The ‘777 reference, however, also does not teach broadcasting text messages that are received from users of source set top boxes. In fact, the ‘777 reference does not receive text messages from users of set top boxes. Instead, the ‘777 reference teaches providing message data sent by hosting services to client devices. *See, e.g.*, paragraphs 0012-0013 and 0019-0022. Applicant notes that the ‘441 reference is not alleged by the Examiner to teach broadcasting text messages received from users of source set top boxes as claimed. Because none of the cited reference teaches such aspects, no reasonable combination of these references can provide correspondence to the claimed invention. Accordingly, the § 103(a) rejections of claims 1-31 are improper and Applicant requests that they be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Schaeffer, of NXP Corporation at (408) 474-9068.

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